

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Basil Naji et al.  
Serial No. : 10/090,561  
Filing Date : March 4, 2002  
Group Art Unit : 1793  
Confirmation No. 5549  
Examiner : Marcantoni, Paul D.  
For : Coatings for Building Products and Methods of Making Same

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**VIA EFS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION FOR WITHDRAWAL OF THE RECORDED TERMINAL DISCLAIMER  
(SUBMITTED UNDER 37 C.F.R. 1.182)**

Dear Sir:

Applicants submit this Petition for Withdrawal of the Recorded Terminal Disclaimer in order to nullify or otherwise cancel the effect of a recorded terminal disclaimer that was erroneously filed before the patent issues. As such, this paper respectfully requests nullification of recorded terminal disclaimer by way of petition for the reasons set forth below as is allowable [see *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968)].

A terminal disclaimer was submitted erroneously on or about June 23, 2005, with pending U.S. Patent Application No. 10/090,561 (hereinafter "the '561 application") to disclaim terminal parts of U.S. Patent No. 6,676,745 (hereinafter "the '745 patent").

Applicants respectfully request the terminal disclaimer be canceled or otherwise nullified.

The rejection as nonstatutory-type double patenting

A nonstatutory-type double patenting rejection was presented during prosecution of the pending '561 application in an Office Action mailed December 23, 2004. In the Office Action, it was stated that the '745 patent did not have identical conflicting claims but "they are not patentably distinct from each other [the '561 application] because all teach compositions comprising cement and fly ash and water in amounts overlapping the instantly claimed invention and process of making as well."

Claims of the pending '561 application

The '561 application, as claimed, is directed to a method of improving a hydraulic binder based coating formulation for coating a building board, the method comprises adding to said hydraulic binder a dewatering agent and water (see all allowed claims, Claims 1-9, 12, 16-20). After application of a thin slurry of the coating formulation to a building product, said slurry is dewatered through the building product (see all allowed claims, Claims 1-9, 12, 16-20). The thin slurry is 0.1 to 10 mm thick (Claims 1-9, 12, 16-19), is dewatered in at least about 120 seconds or less (Claims 16, 20). The thin slurry applied to the building product cures in air in at least about 48 hours (Claim 17).

In Claims 1-9, 12, 16-17 and 20, the dewatering agent comprises fly ash, wherein the fly ash further comprises two components with:

- a first larger size component of a 100 micron maximum size in an amount of about 10 to 60 wt% of the formulation based on total dry ingredients; and
- a second smaller size component of about 10 micron maximum size in an amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients.

In Claims 18 and 19, the dewatering agent comprises fly ash, wherein the fly ash further comprises two components with:

- a first larger size component of greater than 100 microns; and
- a second size component of about 10 micron maximum size in an amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients.

Claims of the '745 patent

Claims of the '745 patent are for a composite building material (Claims 1-20), a material formulation used to form a composite building material (Claims 21-40) and a building material formulation having improved building material's resistance to water and/or environmental degradation (41-52).

Claims 1-20 require the following components in the composite building material:

- a cementitious matrix; and
- cellulose fibers incorporated into the cementitious matrix, at least some of the cellulose fibers having surfaces that are at least partially treated with a sizing agent so as to make the surfaces hydrophobic, wherein the sizing agent comprises a hydrophilic functional group and a hydrophobic functional group, wherein the hydrophilic group is chemically bonded to hydroxyl groups on the fiber surface in the presence of water or an organic solvent in a manner so as to substantially prevent the hydroxyl groups from bonding with water molecules, wherein the hydrophobic group is positioned on the fiber surface and repels water therefrom

Claims 21-40 require the following components in a material formulation used to form a composite building material:

- a cementitious hydraulic binder;
- an aggregate;
- cellulose fibers, at least some of the cellulose fibers having surfaces that are at least partially treated with a sizing agent so as to make the surfaces hydrophobic, wherein the sizing agent comprises a hydrophilic functional group and a hydrophobic functional group, wherein the hydrophilic group is chemically bonded to hydroxyl groups on the fiber surface in the presence of water or an organic solvent in a manner so as to substantially prevent the hydroxyl groups from bonding with water molecules, wherein the hydrophobic group is positioned

on the fiber surface and repels water therefrom, wherein the sizing agent remains bonded to the cellulose fibers in a steam saturated environment; and

- one or more additives

Claims 41-52 require the following components in a material formulation used to form a composite building material:

- a cementitious hydraulic binder; and
- individualized reinforcing fibers, wherein at least a portion of the fibers are chemically treated in the presence of water or an organic solvent to improve the building material's resistance to water and/or environmental degradation

Formulations of the '745 patent and methods of making state that the formulations include about 10%-90% cementitious hydraulic binder, about 20%-80% aggregate and about 0.5 to 20% cellulose fibers (Claims 22, 44) OR 20%-50% cementitious binder, about 30%-70% ground silica and about 0.5 to 20% cellulose fibers (Claim 23, 45) OR 40%-90% cementitious binder, about 0%-30% ground silica and about 0.5 to 20% cellulose fibers (Claim 24, 46). The aggregate is silica having a surface area of about 300 to 450 m<sup>2</sup>/kg (Claim 28). Or, the aggregate is selected from ground silica, amorphous silica, micro silica, diatomaceous earth, coal combustion fly and bottom ashes, rice hull ash, blast furnace slag, granulated slag, steel slag, mineral oxides, mineral hydroxides, clays, magnesite or dolomite, metal oxides and hydroxides, polymeric beads, and mixtures thereof (Claim 27).

The sizing agent comprises a silane containing chemical (Claim 2), aqueous emulsions selected from the group consisting of silanes, alkoxysilanes, alkylalkoxysilanes, halide organosilanes, carboxylated organosilanes, epoxyalkoxysilane and silicone emulsions, or mixtures thereof (Claim 3), n-octyltriethoxysilane (Claim 4), organic resins selected from the group consisting of waxes, polyolefins, epoxies and styrene butadiene rubber emulsions (Claim 5), acrylic polymer emulsions (Claim 6), water soluble agents selected from the group consisting of rosin acids, alum, starches, gums, casein, soya protein, alkyl ketene dimers, alkenyl succinic

anhydrides, and stearic acids (Claim 7). The sizing agent and chemically treated fibers of the '745 patent increase ultimate strain of the composite building material (Claims 33, 47), increase the toughness energy of the composite material (Claim 34), reduce the saturated density of the composite building material (Claim 35), reduce the water permeability of the composite building material (Claim 36, 48), reduce the amount of water absorbed and rate of water absorption in the composite building material (Claims 37, 38, 49, 50), reduce the water migration in a wicking test of the composite building material (Claim 39, 51), and improve the freeze-thaw performance of the composite building material (Claim 40, 52).

The '745 patent does not claim a dewatering agent, fly ash in overlapping amounts or a coating

The '745 patent discloses nothing about a dewatering aid that comprises fly ash. In fact, the term "dewatering aid" appears nowhere in the specification or claims of the '745 patent. The '745 patent does not claim fly ash in amounts overlapping the '561 application. The '745 patent does not claim two components of fly ash. The '745 patent also does not claim two components of fly ash in overlapping amounts let alone a coating formulation having two components of fly ash applied as a thin slurry to a building product, said slurry dewatered through the building product and the thin slurry is 0.1 to 10 mm thick.

The only reference to fly ash in the '745 patent claims is that an aggregate in the formulation that may be selected from the group consisting of "coal combustion fly and bottom ashes" and mixtures thereof (Claim 27).

Claims of the '745 patent are not directed to a coating. Rather, claims of the '745 are for a composite building material and its formulation for cementitious products that specifically require sized cellulose fibers or chemically treated fibers to reduce performance of the composite building material, including ultimate strain, toughness, saturated density, and freeze-thaw performance.

Accordingly, claims of the pending '561 application are patentably distinguishable from those of the '745 patent meaning that the '745 patent does not anticipate and is not obvious over

the pending '561 application and cannot be relied on for an obviousness-type double patenting rejection because claims of the '745 patent neither teach nor suggest the claimed subject matter of the pending '561 application or are an obvious variant thereof.

The specification of the '745 patent may be used to understand the meaning of terms in the claims

The specification can be used as a dictionary to learn the meaning of a term in the patent claim. [*Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)].

To understand the meaning of the term building material in the '745 patent, the specification is referred to wherein it is described at Col. 21, l. 40 to Col. 22, ll. 9, that a formulation for a building material is formed into a green or uncured shaped article requiring pre-curing and then curing to become the building material. The building materials are panel sheets, siding, roofing, trim, soffit, backerboard for tile underlay (Col. 20, ll. 17-19, Examples).

Conclusion

The '745 patent does not have identical conflicting claims to the pending '561 application. The '745 patent is also patentably distinct from pending '561 application because the '745 patent does not teach the same composition as claimed in the pending '561 application that comprises fly ash in two components, the '745 patent does not teach overlapping amounts of fly ash as claimed with the '561 application, the '745 patent also does not teach the same process of making the composition of the pending '561 application.

Nullification or cancellation of a recorded terminal disclaimer erroneously submitted before the patent issues—for a terminal disclaimer directed to U.S. Patent No. 6,676,745—is herewith respectfully requested.

Applicants with this Petition submit the fees due under 1.182 and 1.17(f).

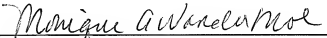
Attorney Docket No. 131279-1019  
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Should additional fees be due to grant nullification of the recorded terminal disclaimer, Applicants authorize the Commissioner to withdraw said fee, which is only for the grant of a nullification, to Gardere Wynne Sewell, Deposit Account No. 07-0153.

Respectfully submitted,

  
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Dated: March 2, 2009

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